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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,042	12/27/1999	ARTHUR SWANBERG	1963/002	8250

7590

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EXAMINER

HARRISON, JESSICA

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/472,042

Applicant(s)

SWANBERG ET AL.

Examiner

Jessica J. Harrison

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 08 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8, 10-14, 16-20, 22, 23, 25-29, 32-35, 38, 41, 44, 45, 48 and 49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 10-14, 16-20, 22, 23, 25-29, 32-35, 38, 41, 44, 45, 48 and 49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. The amendment presented after final on October 9, 2002 has been entered. A new office action, based upon newly cited prior art follows hereinbelow. The examiner apologizes for the delay in preparation of this office action.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 10, 22 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8, 10 and 22 are confusing in that they all depend from cancelled claims. Claim 29 lacks clear antecedent for "said stored statistics".

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 8, 10, 17, 18-20, 22, 23, 25, 27, 35, 38, 41, 44, 45, 48 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Cook et al. 6,427,063 (Cook).

Cook discloses a computerized instructional systems which structurally anticipates the claimed limitations. Cook includes an embedded chip card or smart card 240 having a memory with identification and access software, a local computer having a smart card read/write means, connection to a communications network and a remote server, where the application programs accessed by information contained in the smart card reside and are executed, and wherein the updated data from the remote computer is restored in the smart card. Security features including card specific codes, card type codes, unique user identification, validations and more are discussed in the Cook disclosure. It is important to note that access is provided through the smart card to the execution of software on a remote server in Cook, just as claimed. A thorough reading of the Cook reference will illuminate the patents correspondence to the structure and methodology claimed.

Claims 1, 2, 17, 18, 23, 27, 35, 38, 41, 44, 45, 48 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Roskowski et al 5,624,316

(Rosk). Rosk discloses a video game enhancer unit 4 which includes a smart card with memory, a smart card reader/writer, and connection to a communications network and remote computer for the downloading of information into the local computer and/or smart card in order to alter or enhance the game being played. Note in particular cols 5 – 7, including the teachings of unique identification and security means. A thorough reading of the reference will illuminate the patents correspondence to the structure and methodology claimed.

Claims 1-5, 8, 10, 11, 16, 17, 29, 38, 41, 48 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Sehr 6,325,292.

Sehr discloses a smart card based system and method providing collectable smart cards which have the ability to compile and process collectible information. These smart cards are inserted into a reader/writer contained at a local computer or card station and information contained therein is used to access a card service center or remote database service provider. Unique identification is contained within the smart card, including biometric data, as well as security management through verification. The cards include information printed on the outside of the card which relates to the type of data contained within the card (see col 7:52 – 55 at least). A thorough reading of the reference will illuminate the patents correspondence to the structure and methodology claimed.

Claims 1, 11, 16, 23-28, 29, 32-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Muroi 20020052238A1. Muroi discloses an electronic game system using a smart card recording medium for adding/altering data in the game. As data is used in the game and altered, it may be written back out to the smart card. Muroi teaches at [0017] the game data may be downloaded from a communication network thus inherently implying a remote computer. Muroi's chip card is graphically themed, and teaches updating of the graphics at [0040]. Sports games are suggested at [0037-38] and unique ID of cards suggested at least at [0036]. A thorough reading of the reference will illuminate the patents correspondence to the structure and methodology claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muroi in view of Levy et al. 5,190,285 (Levy).

While Muroi teaches sports games with data from sports figures on the cards, Muroi fails to suggest a plurality of players connected through a network and use of a plurality of cards to create team play. Levy has been cited for his

teaching of two players each selecting a plurality of data cards to create a team and to input data into a video game for game play simulating the teams based upon the selected cards. Such results in a sports simulation game where the game parameters are easily altered and customized therefore appealing to players. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the system and cards of Muroi to allow players to play a sports simulation game by the selecting of a plurality of cards and inputting the data contained thereon in order to create teams with which to play a sports simulation game. Furthermore, as online gaming is notoriously well known, providing such a game through a network connection would have been obvious so that players with the best cards/teams could compete online.

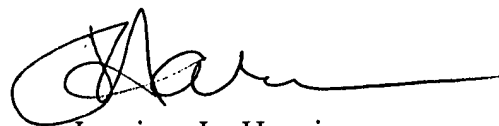
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica J. Harrison whose telephone number is 703-308-2217. The examiner can normally be reached on 8 hour/M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

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A handwritten signature in black ink, appearing to read 'J. Harrison', with a long horizontal flourish extending to the right.

Jessica J. Harrison  
Primary Examiner  
Art Unit 3714

jjh